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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,519	04/26/2000	Peter V. Boesen M.D.	P04179US0	9687

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EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,519

Applicant(s)

BOESEN M.D., PETER V.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004 and 25 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-89,92-100,102 and 103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-89,92-100,102 and 103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

3DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 24 November 2004 and 25 March 2005 has been entered.

2. This communication is in response to the Request for Continued Examination and amendment filed 24 November 2004 and the Response to Restriction Requirement filed 25 March 2005. Claims 84-86, 88, and 92 have been amended. Claims 1-83, 90-91 have been cancelled. Claims 94-104 have been newly added. Claims 100 and 103 have been elected without traverse. Claims 101 and 104 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 84-89, 92-100, 102-103 remain pending

Specification

3. The amendment filed 24 November 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

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a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc. The added material which is not supported by the original disclosure is as follows:

- "storing a relationship defined by the linking wherein the relationship includes rank ordering of the selection of the at least one diagnosis code linked to the selection of the patient procedure code," as disclosed in claim 84, lines 9-11;
- "in rank order," as disclosed in claim 92, line 8
- "wherein the step of linking maintains the defined relationship between the patient procedure code and the at least one diagnosis code," as disclosed in claim 95, lines 1-2;
- "wherein the step of linking maintains a record of the defined relationship between the patient procedure code and the at least one diagnosis code," as disclosed in claim 96, lines 1-2;
- "wherein the defined relationship is a care provider defined relationship," as disclosed in claim 97, lines 1-2;
- "a rank ordered relationship," as disclosed in claim 98, lines 7-8.

In particular, Applicant does not point to, nor was the Examiner able to find, any support for this newly added language within the specification as originally filed on 26 April 2000. As

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such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 26 April 2000.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 84-89, 92-100, 102-103 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Independent claims 84, 92, and 98 and dependent claims 95-97 recite limitations that are new matter, as discussed above, and are therefore rejected.

(B) Claims 85-89, 93-97, 99-100, and 102-103 incorporate the features of independent claims 84, 92, and 98, through dependency and are also rejected.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 95-97 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claims 95-97 recite the limitation "the defined" in lines 1, 2, and 1, respectively.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 84, 88-89, 94-100, 102-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al., U.S. Patent Number 6, 393, 404 in view of Dorne, U.S. Patent Number 5, 325, 293.

(A) Claim 84 has been amended to include the recitation of

- ♦ "storing a relationship defined by the linking wherein the relationship includes rank ordering of the selection of the at least one diagnosis code linked to the selection of the patient procedure code " in lines 9-11; and
- ♦ "the selection of the" in line 7.

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As per newly amended claim 84, Waters discloses a method for providing medical coding, comprising:

receiving a selection of a patient procedure code on a first computer (Waters; Figure 3, column 3, lines 52-65);

receiving a selection of at least one diagnosis code on the first computer (Waters; Figure 2, column 3, lines 30-51).

Although Waters teaches linking the patient procedure code to the diagnosis code (Waters; column 3, lines 53-65), Waters fails to explicitly disclose

linking the selection of the patient procedure code to the selection of the at least one diagnosis code on the first computer; and

storing a relationship defined by the linking wherein the relationship includes rank ordering of the selection of the at least one diagnosis code linked to the selection of the patient procedure code.

However, the above features are well-known in the art, as evidenced by Dorne.

In particular, Dorne teaches

linking the selection of the patient procedure code to the selection of the at least one diagnosis code on the first computer (Dorne; column 16, lines 9-22); and

storing (in memory) “all of the likely ICD-9 codes associated with the procedures that the user has selected” (reads on “a relationship defined by the linking”) (Dorne; column 16, lines 14-16), wherein the relationship includes “keeping track of the ICD-9 diagnostic codes most likely associated with the procedures selected by the user” (reads on “rank ordering of the selection of

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the at least one diagnosis code linked to the selection of the patient procedure code”) (Dorne; column 16, lines 9-12, 20-21, column 12, lines 46-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Waters to include the claimed limitations, as taught by Dorne, with the motivations of providing a method and system for rapidly, simply and accurately correlating diagnosis and procedure codes with medical procedures performed during a patient examination which does not require a thorough understanding of the nomenclature used by the coding system, reducing time spent coding by busy physicians, and enabling more efficient payments from Medicare and private insurance companies for physician’s services (Dorne; column 3, lines 10-28).

(B) As per claims 88-89, Waters and Dorne teach a method as analyzed and discussed in claim 84 above

further comprising associating the patient procedure code and the linked at least one diagnosis code with patient data including patient identifying information (Waters; column 4, lines 2-8);

further comprising sending patient data, including patient identifying information to the first computer from a second computer prior to the steps of receiving a selection of a patient procedure code and receiving a selection of a diagnosis code (Waters; column 4, lines 2-8).

(C) As per newly added claims 94-97, Waters and Dorne teach a method as analyzed and discussed in claim 84 above further comprising

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generating a patient bill based on the selection of the patient procedure code and the selection of the at least one diagnosis code (Dorne; column 3, lines 18-39, column 19, lines 9-19);

wherein the step of linking maintains the defined relationship between the patient procedure code and the at least one diagnosis code (Dorne; column 3, lines 29-39, column 16, lines 9-22);

wherein the step of linking maintains a record of the defined relationship between the patient procedure code and the at least one diagnosis code (Dorne; column 3, lines 29-39, column 16, lines 9-22); and

wherein the defined relationship is a care provider defined relationship (Dorne; column 3, lines 18-39).

The motivations for combining the respective teachings of Waters and Dorne are as given in the rejection of claim 84 above, and incorporated herein.

(D) Claim 98 differs from claim 84 in that it is a method for providing code-driven medical reporting for billing purposes rather than a method for providing medical coding.

As per newly added claim 98, Waters and Dorne teach a method for providing code-driven medical reporting for billing purposes, comprising:

receiving a selection of a patient procedure code on a first computer (Waters; Figure 3, column 3, lines 52-65;

receiving a selection of at least one diagnosis code on the first computer (Waters; Figure 2, column 3, lines 30-51);

linking the selection of the patient procedure code to the selection of the at least one diagnosis code on the first computer (Dorne; column 16, lines 9-22), wherein the linking of the selection of the patient procedure code and the selection of the at least one diagnosis code provides for “keeping track of the ICD-9 diagnostic codes most likely associated with the procedures selected by the user” (reads on “maintaining a rank ordered relationship between the patient procedure code and the at least one diagnosis code”) to thereby provide a detailed record of an encounter (Dorne; column 16, lines 9-12, 20-21, column 12, lines 46-50).

The motivations for combining the respective teachings of Waters and Dorne are as given in the rejection of claim 84 above, and incorporated herein.

(E) As per newly added claims 99-100, 102-103, Waters and Dorne teach a method as analyzed and discussed in claims 84 and 97 above

wherein each of the at least one diagnosis code is an ICD-9 code (Dorne; column 16, lines 9-19);

wherein the patient procedure code is a CPT code (Dorne; column 16, lines 20-21);

wherein a modifier is associated with the patient procedure code (Dorne; Figure 7, column 8, line 63 to column 9, line 2, column 10, lines 10-13);

wherein a unit value or RVU is assigned to the patient procedure code (Dorne; Figure 3G, column ;1, lines 21-26, column 6, line 66 to column 7, line 4).

The motivations for combining the respective teachings of Waters and Dorne are as given in the rejection of claim 84 above, and incorporated herein.

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11. Claims 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al., U.S. Patent Number 6, 393, 404 and Dorne, U.S. Patent Number 5, 325, 293, as applied to claim 84 above, and further in view of Lavin et al, Pat. No. 5,772,585.

(A) As per claim 85, Waters and Dorne teach a method as analyzed and discussed in claim 84 above.

Waters and Dorne fail to explicitly disclose electronically sending patient data including the patient procedure code and the linked at least one diagnosis code from the first computer to a second computer.

However, the above features are well-known in the art, as evidenced by Lavin.

In particular, Lavin teaches electronically sending patient data including the patient procedure code and the linked at least one diagnosis code from the first computer to a second computer (Lavin; column 9, lines 34-56, column 13, lines 29-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Waters and Dorne to include the claimed limitations, as taught by Lavin, with the motivations of providing a method for concurrently recording examination and diagnoses notes in a database during patient examination and enabling data entry and access to multiple items of information, previously recorded on separate paper and electronic media, at a common user interface and database structure simultaneously by more than one user, thus eliminating redundant data entry and centralization of patient information (Lavin; column 2, line 65 to column 3, line 11).

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(B) As per claim 86-87, Waters, Dorne and Lavin teach a method as analyzed and discussed in claim 84 above

further comprising displaying the patient procedure code and the linked at least one diagnosis code on a display of the first computer prior to the step of electronically sending (Waters; Figure 2, Figure 3, column 3, lines 53-64);

generating a patient bill at the second computer, the patient bill associated with the patient data (Lavin; column 9, lines 38-40 and column 13, lines 56-59).

The motivations for combining the respective teachings of Waters, Dorne and Lavin are as given in the rejection of claims 84 and 85 above, and incorporated herein.

12. Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guadagnino, Christopher, "Documentation and coding tools" (hereinafter Guadagnino) for substantially the same reasons given in the previous Office Action (paper number 082004), and further in view of Dorne, U.S. Patent Number 5, 325, 293. Further reasons appear hereinbelow.

(A) Claim 92 differs from claim 84 in that it is a a method for providing code-driven medical reporting rather than a method for providing medical coding.

Claim 92 has been amended to now recite,

- ♦ "receiving a selection of at least one diagnosis code on a first computer" at line 3;
- ♦ "in rank order to the patient procedure code," in lines 6-7.

As per newly amended Claim 92, Guadagnino discloses a method for providing code-driven medical reporting (i.e. CodeMaster express)(pages 4-5), comprising:

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receiving a selection of at least one diagnosis code on a first computer (Guadagnino; pages 4-5); and

receiving a selection of a patient procedure code on the first computer (Guadagnino; pages 4-5).

Although Guadagnino teaches linking the at least one diagnosis code “in descending order of probable applicability,” and “link diagnosis codes to procedure codes” such that a defined relationship between the patient procedure code and the at least one diagnosis code is maintained (Guadagnino; pages 4-5), Guadagnino fails to explicitly disclose

linking the at least one diagnosis code in rank order to the patient procedure code.

However, the above features are well-known in the art, as evidenced by Dorne.

In particular, Dorne teaches

linking the at least one diagnosis code “most likely associated with the procedures selected by the user” (reads on “in rank order to the patient procedure code”) (Dorne; column 16, lines 9-12, 20-21, column 12, lines 46-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Guadagnino to include the claimed limitations, as taught by Dorne, with the motivations of providing a method and system for rapidly, simply and accurately correlating diagnosis and procedure codes with medical procedures performed during a patient examination which does not require a thorough understanding of the nomenclature used by the coding system, reducing time spent coding by busy physicians, and enabling more efficient payments from Medicare and private insurance companies for physician’s services (Dorne; column 3, lines 10-28).

13. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guadagnino, Christopher, "Documentation and coding tools" (hereinafter Guadagnino) and Dorne, U.S. Patent Number 5, 325, 293, as applied to claim 92 above, and further in view of Lavin, for substantially the same reasons given in the previous Office Action (paper number 082004). Further reasons appear hereinbelow.

(A) As per Claim 93, Guadagnino and Dorne teach a method as analyzed and discussed in claim 92 above.

Guadagnino and Dorne fail to explicitly disclose a method further comprising generating a bill based on the patient procedure code and the at least one diagnosis code.

However, the above features are well-known in the art, as evidenced by Lavin.

In particular, Lavin teaches

generating a bill based on the patient procedure code and the at least one diagnosis code (Lavin; column 13, lines 8-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Guadagnino and Dorne to include the aforementioned limitations, as taught by Lavin, with the motivations of easily and automatically generating a patient bill after an office visit (Lavin; column 13, lines 55-58).

Response to Arguments

14. Applicant's arguments on pages 6-9 of the response filed 24 November 2004 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Rappaport, U.S. Patent Application Number 2002/0007285, Lutgen et al., U.S. Patent Application Number 2003/0167189, Tallman et al., U.S. Patent Number 5, 471, 382, Stoodley, U.S. Patent Number 6, 611, 846, Norman, Jr., U.S. Patent Number 6, 738, 754, McCartney, U.S. Patent Number 5, 778, 345, teach the environment of associating codes with medical services.

16. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. After Final communications should be labeled "Box AF."

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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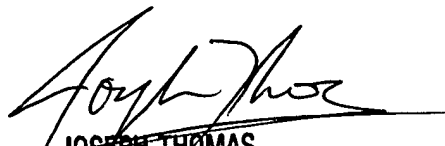
18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NP

Natalie A. Pass

September 13, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600